

R E M A R K S

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the following remarks. Prior to the Office Action, claims 1-10 were pending. Claim 1-3, 5 and 6 have been amended. Claims 11-22 have been added. Claims 1, 4 and 18 are independent.

Drawings

A replacement formal drawing is attached for FIG. 9. In FIG. 9, the duplicate numbering of the power supply switch has been changed to "33" and the misspelling of "OPERATING" has been corrected. No new matter has been added by the changes to the drawing reflected in the accompanying replacement formal drawing. It is respectfully requested that these objections to the drawings be withdrawn.

Specification

The Examiner objects to the title of the invention, because allegedly it is not indicative of the invention. This objection is traversed. According to MPEP 606, the "title should be brief but technically accurate and descriptive and should contain fewer than

500 characters." It is respectfully submitted the title is brief, technically accurate and descriptive of the invention. It is requested that this object be withdrawn. Alternatively, the Examiner is requested to suggest a title.

The Subject Matter of the Present Application

The present application is generally directed to a new form of memory card and its use with an image processing device such as a digital camera, printer or the like. In prior systems, the image processing device had a dedicated display and the memory card had no display. In accordance with the teachings of the present application, a memory card is provided with a display and the card is mountable on a image processing device to both act as a memory and display thereof. The display is a transmission display and a illumination device is provided to backlight the display when the memory card is attached to the image processing device.

Rejection under 35 U.S.C. §103(a) based on No and Maeda

Claims 1, 4 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over No (U.S. Patent No. 6,587,140) in view of

Maeda (U.S. Patent No. 6,072,465). Applicant respectfully traverses this rejection.

Regarding the applied rejection against independent claims 1 and 4, Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the claim limitations, see *In re Vaeck*, 947 F.2d 48, 20 USPQ2d 1438 (Fed.Cir.1991).

According to claims 1, a image processing apparatus for use with a memory card includes an electronic image receiving element and a receiving area for the memory card. The memory card includes a transmission-type image display and the image processing apparatus is provided with a light source to illuminate the display. In claim 4, a transmission-type display panel is included in a memory card. The user can see the image displayed on the transmission-type liquid crystal panel when the memory card is

mounted (received) in the digital electronic camera. Additionally, when the memory card is removed from the digital camera, the user can still see the image on the transmission-type display.

In No, although the card 7 includes a display (LCD) screen 18, the digital camera 3 does not have an opening at a location corresponding to a back side of the transmission-type liquid crystal panel. Consequently, the display in No must be illuminated in some other, likely less energy efficient, manner. The Examiner states that "No is silent with regard to including a transmission-type LCD that has an opening in the back, wherein the camera illuminates the opening." While this language is not present in any of the claims, the examiner does acknowledge this general deficiency in No. The examiner applies Maeda to allegedly correct this defect of No.

Maeda discloses a notebook computer 1 that has a front bezel 1B, a center bezel 1C and a rear cover 1D. A liquid crystal display (LCD) is provided in the center of the front bezel 1B. The center bezel 1C is hinged with the PC main body 1A and can not be removed therefrom, (see column 16, lines 26-27). The front bezel 1B is detachably mounted on the front face of the center bezel 1C,

while the rear cover 1D is detachably mounted on the rear face (see column 12, lines 35-64).

When the rear cover 1D is removed from the center bezel 1C, the LCD 21 becomes transparent, and can thus be used as a substitute for an overhead projector (OHP) (see column 13, lines 1-4).

Since the front bezel 1B of Maeda is not a memory card, there is little relevance in Maeda to the claimed invention of the independent claims. In essence the only value of Maeda to the rejection combination is to disclose a transmission display.

The Office Action alleges that it would have been obvious to modify the memory card of No to include an opening in the rear for use with an illuminating light in accordance with the teachings of Maeda which shows an overhead projector in Figure 12. The Examiner utilizes "Official Notice" to provide motivation.

It is respectfully submitted that "Official Notice" is not enough to show a motivation or suggestion as required. Official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the

court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA) 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute." (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961). *MPEP* 2144.03.

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

In this instance, it appears that the only motivation to combine has been gleaned from the teachings of the present application. This constitutes impermissible hindsight, however.

See MPEP 2141. Simply put, there is no showing in the Office Action that the conclusion of obviousness was reached on the basis of facts gleaned from the prior art, and not from the claimed invention. See MPEP 2143.

Indeed, the cited reference must be considered in its entirety including disclosures that teach away from the claimed invention. See M.P.E.P. 2142.02. If the proposed modification renders the cited reference unsatisfactory for its intended purpose, then by definition, there is no suggestion or motivation to make the proposed modification. See M.P.E.P. 2143.01. Thus, if the proposed modification renders the cited reference unsatisfactory for its intended purpose, the rejection must fail.

In this instance, No specifically demonstrates only two devices for utilizing as the imaging system. No contemplates a couple of other devices and describes these in column 5, line 64 through column 6, line 6 wherein it is stated that "while the imaging system has been described in terms of a camera and a printer, the system may be used with any other kind of imaging rendering device, such as an electronic photo-album, a PC video screen, a scanner, a transfer station, or an archive station. The camera may be still or video. While the intelligence circuit of

the invention has been described in terms of a PC card, this circuit can assume the form of any portable module that is detachably connectable to both a digital camera or printer."

In other words, No only suggests using portable modules that connect to a digital camera or printer. Maeda is a notebook computer, see column 1, lines 22-28, not a pc card, circuit or portable module that connects to a digital camera or a printer. Consequently, Maeda is unrelated to the field to which the present application and No are directed, memory cards employing displays and further can not motivate one to modify the No display in the claimed manner, there being no teaching of the advantage of a transmissive display in a memory card.

The Examiner states, in rejecting independent claims 1 and 4 under 35 U.S.C. §103, that "it would be obvious to one of ordinary skill to have No's memory card include an opening in the rear for use with an illuminating light." The Examiner asserts that "[a]n advantage to using an LCD panel that is removable from a housing that contains an illumination source is that alternative sources of illumination may be used, such as the overhead projector shown in Figure 12." Applicant respectfully submits that this conclusionary

statement made by the Examiner is not a proper basis to substantiate an obviousness rejection.

Recent Federal Circuit case law precedent makes it explicitly clear that the factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority, but must be read on the objective evidence of the record. Federal Circuit case law precedent further requires that "common sense and common knowledge" alone is improper evidence in support of an obviousness rejection.

The Examiner purports a common sense and common knowledge reason for the deficiencies of No, in other words, stating that No would have suggested a similar technique. However, common sense and knowledge are not objective evidence of record, as the Federal Circuit explains, but are in fact commensurate with subjective belief and unknown authority. Therefore, the Examiner has failed to meet the legal requirements to substantiate the obviousness rejection.

For an illuminating discussion on the burden placed on an Examiner to establish objective factual findings of record, the Examiner is referred to the recent Federal Circuit decision of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002).

In re Lee involved an appeal of a decision of the Board of Patent Appeals in which *Lee* argued that the Examiner failed to provide a source of a teaching, suggestion, or motivation to combine the applied prior art to arrive at the claimed invention. The Board responded to these arguments by ruling that "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *Id.* at 1432. The Federal Circuit overturned the Board's decision "for failure to meet the adjudicative standards for review under the administrative procedure act." *Id.* at 1431. The Federal Circuit further stated that "the factual inquiry whether to combine references must be thorough and searching...it must be based on objective evidence of record...[t]his precedent has been reinforced in a myriad of decisions and cannot be dispensed with." *Id.* at 1433. The Court also stated that the USPTO is "not free to refuse to follow Circuit precedent" and "cannot rely on conclusionary statements when dealing with particular combinations of prior art and specific claims." *Id.* at 1434.

As stated herein above, the Examiner's asserted modification for No which is "to have No's memory card include an opening in the

rear for use with an illuminating light" and the lack of factual support thereof comports very closely to the analysis disapproved by the Federal Circuit in *In re Lee*. As such, the Examiner's failure to provide factual support for a teaching, suggestion or motivation to modify No constitutes legal error.

Therefore, the combination of No and Maeda is improper. Thus, independent claims 1 and 4 are distinguishable over No and Maeda.

Dependent claims 2, 3 and 5-10

It is respectfully submitted that claims 2, 3 and 5-10 depend directly or indirectly from independent claims 1 and 4. Therefore, these dependent claims are also distinguishable over the combination of No and Maeda for at least the reasons stated with respect to the independent claims.

Applicant respectfully requests withdrawal of all the rejections of claims 1-10 under 35 U.S.C. §103 based on No and Maeda.

Rejection under 35 U.S.C. §103(a) based on No, Maeda, and Kimura

Claims 2 and 6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over No in view of Maeda and further in view of U.S.

Patent No. 5,016,223 to Kimura. Applicant respectfully traverses this rejection.

For a Section 103 rejection to be valid, a *prima facie* case of obviousness must be established. See *M.P.E.P.* 2142. One requirement to establish a *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited reference(s) to modify the reference(s) as proposed in the Office Action. See *M.P.E.P.* 2143.01.

It has been shown that independent claims 1 and 4 are distinguishable over the combination of No and Maeda. Kimura has not been, and indeed cannot be, relied upon to correct at least the above deficiencies of No and Maeda. Therefore, independent claims 1 and 4 are distinguishable over the combination of No, Maeda, and Kimura.

The Examiner states that No fails to teach or suggest a memory card insertion detection device. The Examiner relies on the teachings of Kimura because, according to the Examiner, "it would have been obvious to one of ordinary skill in the art at the time of [the] invention to have No's memory card receive a power supply control signal from its docking device, similar to Kimura's system."

It appears that an obviousness has been assumed merely on the assumption that the combination of the references includes all claimed elements. However, it is well established that even if the combination of the references teaches every element of the claimed invention, without some motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. See MPEP 2143.01.

Claims 2 and 6 depend directly or indirectly from independent claims 1 and 4. Therefore, these dependent claims are also distinguishable over the combination of No, Maeda and Kimura for at least the reasons stated with respect to the independent claims.

Applicant respectfully requests withdrawal of the rejection of claims 2 and 6 under 35 U.S.C. §103 based on No, Maeda, and Kimura.

Rejection under 35 U.S.C. §103(a) based on No, Maeda, Kimura and Yoshimura

Claims 3 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over No in view of Maeda and further in view of U.S. Patent No. 5,016,223 to Kimura and U.S. Patent No. 5,950,013 to Yoshimura. Applicant respectfully traverses this rejection.

For a Section 103 rejection to be valid, a *prima facie* case of obviousness must be established. See M.P.E.P. 2142. One

requirement to establish a *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited reference(s) to modify the reference(s) as proposed in the Office Action. See M.P.E.P. 2143.01.

It has been shown that independent claims 1 and 4 are distinguishable over the combination of No and Maeda. Kimura has not been, and indeed cannot be, relied upon to correct at least the above deficiencies of No and Maeda, and neither can Yoshimura. Therefore, independent claims 1 and 4 are distinguishable over the combination of No, Maeda, Kimura and Yoshimura.

The Examiner indicates that "[b]oth No and Kimura are silent with regard to including a chargeable battery charged by a charging controller." The Examiner also indicates that Yoshimura is does not teach or suggest "a charging controller." Applicant agrees with the Examiner.

The Examiner states that "[r]egarding claim 9, both No and Kimura are silent with regard to including a chargeable battery charged by a charging controller." This is a miss characterization of claim 9. There is no chargeable battery charged by a charging controller recited in claim 9. Instead, claim 9 recites as follows:

--The memory card according to claim 6, further comprising a charging circuit, which is supplied with a voltage from the image processing apparatus in response to detection of insertion of said memory card into the image processing apparatus by said insertion detection device, for charging said power supply by this supplied voltage.--

Accordingly, it is respectfully requested that the Examiner withdraw this rejection of claim 9, since the rejection is based on a feature that is not in the claim.

Claims 3 and 9 depend directly or indirectly from independent claims 1 and 4. Therefore, these dependent claims are also distinguishable over the combination of No, Maeda and Kimura for at least the reasons stated with respect to the independent claims.

Applicant respectfully requests withdrawal of the rejection of claims 3 and 9 under 35 U.S.C. §103 based on No, Maeda, Kimura and Yoshimura.

Rejection under 35 U.S.C. §103(a) based on No, Maeda and Oda

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over No in view of Maeda and further in view of U.S.

Patent No. 5,490,117 to Oda. Applicant respectfully traverses this rejection.

For a Section 103 rejection to be valid, a *prima facie* case of obviousness must be established. See *M.P.E.P.* 2142. One requirement to establish a *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited reference(s) to modify the reference(s) as proposed in the Office Action. See *M.P.E.P.* 2143.01.

It has been shown that independent claim 4 is distinguishable over the combination of No and Maeda. Oda has not been, and indeed cannot be, relied upon to correct at least the above deficiencies of No and Maeda. Therefore, independent claim 4 is distinguishable over the combination of No, Maeda, and Oda.

Claim 7 depends directly from independent claim 4. Therefore, this dependent claim is also distinguishable over the combination of No, Maeda and Oda for at least the reasons stated with respect to the independent claim 4.

Applicant respectfully requests withdrawal of the rejection of claim 7 under 35 U.S.C. §103 based on No, Maeda, and Oda.

Rejection under 35 U.S.C. §103(a) based on No, Maeda, Oda and
Kimera

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over No in view of Maeda and further in view of Oda and Kimera. Applicant respectfully traverses this rejection.

For a Section 103 rejection to be valid, a *prima facie* case of obviousness must be established. See *M.P.E.P.* 2142. One requirement to establish a *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited reference(s) to modify the reference(s) as proposed in the Office Action. See *M.P.E.P.* 2143.01.

It has been shown that independent claim 4 is distinguishable over the combination of No and Maeda. Oda has not been, and indeed cannot be, relied upon to correct at least the above deficiencies of No and Maeda, nor can Kimura. Therefore, independent claim 4 are distinguishable over the combination of No, Maeda, Oda and Kimura.

Claim 8 depends directly from independent claim 4. Therefore, this dependent claim is also distinguishable over the combination of No, Maeda, Oda and Kimura for at least the reasons stated with respect to the independent claim 4.

Applicant respectfully requests withdrawal of the rejection of claim 8 under 35 U.S.C. §103 based on No, Maeda, Oda and Kimura.

Rejection under 35 U.S.C. §103(a) based on No, Maeda, Oda and Yoshimura

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over No in view of Maeda and further in view of Oda and Yoshimura. Applicant respectfully traverses this rejection.

For a Section 103 rejection to be valid, a *prima facie* case of obviousness must be established. See *M.P.E.P.* 2142. One requirement to establish a *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited reference(s) to modify the reference(s) as proposed in the Office Action. See *M.P.E.P.* 2143.01.

It has been shown that independent claim 4 is distinguishable over the combination of No and Maeda. Oda and Yoshimura have not been, and indeed cannot be, relied upon to correct at least the above deficiencies of No and Maeda. Therefore, independent claim 4 is distinguishable over the combination of No, Maeda, Oda and Yoshimura.

Claim 10 depends directly from independent claim 4. Therefore, this dependent claim is also distinguishable over the combination of No, Maeda, Oda and Yoshimura for at least the reasons stated with respect to the independent claim 4.

Applicant respectfully requests withdrawal of the rejection of claim 10 under 35 U.S.C. §103 based on No, Maeda, Oda and Yoshimura.

Claims 11-22

New claims 11-22 recite additional features of the present application. Claim 18 is an independent claim, and it is submitted that this claim is also distinguishable over the references for the reasons generally advanced with respect to the claims discussed above.

Conclusion

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance, and such allowance is earnestly solicited.

Appl. No. 09/392,445
Reply to Office Action of July 25, 2003
Atty. Docket: 0905-0222P

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Daniel K. Dorsey (Reg. No. 32,520) at the telephone number of the undersigned below.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a two (2) month extension of time for filing a reply in connection with the present application, and the required fee of \$420.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s): Replacement Sheet containing Fig. 9